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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,496	10/18/2001	Ryszard Sprycha	C-411	7480
27384	7590	04/11/2005	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD STREET 18TH FLOOR NEW YORK, NY 10022			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,496

Applicant(s)

SPRYCHA ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/21/05 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 3 and 29 each recite “non-fluorescent” pigment. However, the cited phraseology clearly signifies a “negative” or “exclusionary” limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35

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USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453. Applicant has not pointed to any portion of the specification, and examiner has not found any support for this phraseology in the specification as originally filed.

The insertion of the above phraseology “non-fluorescent” positively excludes fluorescent pigments, however, there is no support in the present specification for such exclusion. While the present specification is silent with respect to the use of fluorescent pigments, is noted that as stated in MPEP 2173.05(i), the “mere absence of a positive recitation is not the basis for an exclusion.”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-8, 15-16, 18-22, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Zhu (U.S. 6,251,175) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

Zhu discloses non-aqueous ink comprising polyamide, solvent such as ethanol, up to 2% ammonium hydroxide, and pigment (col.3, lines 9-10, 13, and 30, col.4, line 10, col.5, line 34, and col.7, lines 22 and 28-30,).

Although there is no disclosure that using ammonium hydroxide in the ink results in increase in stability and resolubility of the ink, given that Zhu disclose ink identical to that presently claimed including base as presently claimed, it is clear that the use of ammonium hydroxide in the ink will inherently result in increase in stability and resolubility.

Further, although there is no disclosure in Zhu that the ink is a lamination ink, it is well known, as evidenced by either EP 1219462 (paragraph 5) or Wexler (col.1, lines 39-40), that ink jet inks can in fact be laminated and thus, function as lamination inks.

In light of the above, it is clear that Zhu anticipates the present claims.

6. Claims 1, 3-10, 12-15, 17-24, and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Trauernicht et al. (U.S. 6,247,801) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

Trauernicht et al. disclose non-aqueous ink comprising resin, organic solvent which is ethanol or propanol, pigment such as carbon black or phthalocyanine, and 0.1-10% pH control agent including sulfuric acid, acetic acid, hydrochloric acid, alkali metal hydroxide, and triethanolamine (col.2, lines 29-33, col.3, lines 59-60, col.4, lines 10-13 and 47-50, and col.5, lines 7-20).

Although there is no disclosure that using acid or base in the ink results in increase in stability and resolubility of the ink, given that Trauernicht et al. disclose ink identical to that

presently claimed including acid and base as presently claimed, it is clear that the use of such acid and base in the ink will inherently result in increase in stability and resolubility.

Further, although there is no disclosure in Trauernicht et al. that the ink is a lamination ink, it is well known, as evidenced by either EP 1219462 (paragraph 5) or Wexler (col.1, lines 39-40), that ink jet inks can in fact be laminated and thus, function as lamination inks.

In light of the above, it is clear that Trauernicht et al. anticipates the present claims.

7. Claims 1-3, 5, 7-10, 15-17, 19, 21-24, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mead et al. (U.S. 5,596,027) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

Mead et al. disclose non-aqueous ink comprising polyamide, pigment such as monoarylide yellow, diarylide yellow, lithol rubine, phthalocyanine, and carbon black, and 2-15% sodium hydroxide, potassium hydroxide, ammonium hydroxide, ethanolamine, triethanolamine, and dimethylethanolamine (col.4, lines 36-37, col.7, lines 12-39, col.9, lines 50-51, col.10, line 21, and col.12, lines 26-31 and 40-44).

Although there is no disclosure that using base in the ink results in increase in stability and resolubility of the ink, given that Mead et al. disclose ink identical to that presently claimed including base as presently claimed, it is clear that the use of such base in the ink will inherently result in increase in stability and resolubility.

Further, although there is no disclosure in Mead et al. that the ink is a lamination ink, it is well known, as evidenced by either EP 1219462 (paragraph 5) or Wexler (col.1, lines 39-40), that ink jet inks can in fact be laminated and thus, function as lamination inks.

In light of the above, it is clear that Mead et al. anticipates the present claims.

8. Claims 1, 11, 15, 23, 25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (U.S. 5,922,118) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

Johnson et al. disclose nonaqueous ink comprising pigment, solvent, resin (binder), and aminoalcohol which clearly encompasses the specific aminoalcohols presently claimed (col.10, lines 47-49 and col.12, lines 29 and 42)

Although there is no disclosure that using aminoalcohol in the ink results in increase in stability and resolubility of the ink, given that Johnson et al. disclose ink identical to that presently claimed including aminoalcohol as presently claimed, it is clear that the use of such aminoalcohol in the ink will inherently result in increase in stability and resolubility.

Further, although there is no disclosure in Johnson et al. that the ink is a lamination ink, it is well known, as evidenced by either EP 1219462 (paragraph 5) or Wexler (col.1, lines 39-40), that ink jet inks can in fact be laminated and thus, function as lamination inks.

In light of the above, it is clear that Johnson et al. anticipates the present claims.

9. Claims 1, 3, 5-7, 9-10, 12, 14-15, 17, 19-21, 23-24, and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Tatum et al. (U.S. 6,379,441) taken in view of the evidence in either EP 1219462 or Wexler (U.S. 6,454,896).

Tatum et al. disclose non-aqueous ink jet ink comprising polymer, pigment such as phthalocyanine and carbon black, organic solvent, and neutralizer including inorganic acid,

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organic acid such as acetic acid or citric acid, and organic base such as amine. The neutralizer is present in amount of, for instance, 1% (col.1, line 3, col.2, lines 61-67, col.3, lines 6-17, 49-55, and 59-67, col.4, lines 8-14 and 34-35, and Table 1).

Although there is no disclosure that using acid or base in the ink results in increase in stability and resolubility of the ink, given that Tatum et al. disclose ink identical to that presently claimed including acid or base as presently claimed, it is clear that the use of such acid or base in the ink will inherently result in increase in stability and resolubility.

Further, although there is no disclosure in Tatum et al. that the ink is a lamination ink, it is well known, as evidenced by either EP 1219462 (paragraph 5) or Wexler (col.1, lines 39-40), that ink jet inks can in fact be laminated and thus, function as lamination inks.

In light of the above, it is clear that Tatum et al. anticipates the present claims.

10. Claims 1-8, 15-22, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 621319.

EP 621319 discloses non-aqueous ink jet ink comprising polyamide, pigment such as phthalocyanine, organic solvent including alcohol such as isopropanol or ethanol, and 0.1-10% inorganic base such as sodium hydroxide or potassium hydroxide (page 1, lines 3-8, page 6, lines 1-6 and 44-50, page 4, lines 20, 24-25, and 30-36, page 6, lines 1-23, and examples 3 and 11).

Although there is no disclosure that using base in the ink results in increase in stability and resolubility of the ink, given that EP 621319 discloses ink identical to that presently claimed including base as presently claimed, it is clear that the use of such base in the ink will inherently result in increase in stability and resolubility.

While there is no disclosure that the ink of EP 621319 is a “lamination ink” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. lamination ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art ink which is identical to ink set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that EP 621319 anticipates the present claims.

Response to Arguments regarding 35 USC 112, 1st paragraph rejection

11. Applicants’ arguments regarding the 35 USC 112, 1st paragraph rejection of record have been fully considered but they are not persuasive.

In the office action mailed 2/20/04, it was the examiner's position that the use of the phrase "non-fluorescent" clearly signified a "negative" or "exclusionary" limitation for which applicants had no support in the original disclosure. The examiner noted that negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, 1st paragraph, *Ex parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. & Inter. 1983).

In response, applicants argue that unlike *Grasselli*, where there was no support in the original specification for the added negative limitation, in the present instance, the added negative limitation is supported by the original specification as evidenced by, for example, claims 3 and 17 that specify types of fluorescent pigments. Applicants also argue that although the phrase "non-fluorescent" may not be used in the present specification, the concept embodied by "non-fluorescent" pigment is found in the original specification and therefore, the phrase "non-fluorescent" does not introduce new matter. Applicants further argue that although "non-fluorescent" is a negative limitation, there is nothing inherently ambiguous or uncertain about the limitation given that the limitation has basis in the original disclosure.

However, the examiner's position remains that the use of the phrase "non-fluorescent" does introduce new concepts and violates the description requirement of 35 USC 112, 1st paragraph for the following reasons.

The insertion of the phrase "non-fluorescent" positively excludes fluorescent pigments, however, there is no support in the specification for such exclusion. While present claims 3 and 17 do disclose only non-fluorescent pigments and only non-fluorescent pigments are disclosed in the specification, this does not provide a basis to exclude fluorescent pigments. As stated in

MPEP 2173.05(i), the “mere absence of a positive recitation is not the basis for an exclusion”. Further, the use of negative limitations introduce new concepts given that the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly included. Thus, in the present claims, the express exclusion of fluorescent pigments implies the inclusion of all non-fluorescent pigments for which there is no support in the present specification. While there is support for the specific non-fluorescent pigments recited in present claims 3 and 17, there is no support for the inclusion of all non-fluorescent pigments. Additionally, support for examiner’s position is found in *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953), where the courts held that a negative limitation rendered the claim indefinite because it was an “attempt to claim the invention by excluding what the invention did not invent rather than distinctly and patentably point out what they did invent”.

Response to Arguments regarding 35 USC 102 rejections

12. Applicants’ arguments filed 1/21/05 have been fully considered but they are not persuasive.

Specifically, applicants argue that none of the cited references utilized against the present claims is relevant given that each of the references discloses aqueous ink which is in direct contrast to the present claims that require non-aqueous ink.

With respect to Zhu et al., applicants point to col.3, lines 24-26 of Zhu et al. that discloses that small quantities of water can be used in the carrier to provide necessary electrical conductivity when using non-aqueous solvents. Further, in light of this disclosure, applicants

argue that one of ordinary skill in the art would utilize the water-soluble compounds of Zhu in Zhu's aqueous embodiments.

However, it is noted that the use of water in Zhu is not required, i.e. water "can be" used. Further, it is noted that none of the example of Zhu utilize water in any amount. Additionally, even if Zhu et al. did require the use of small quantities of water, there is nothing in the scope of the present claims which requires that the ink contain no water. That is, there is no disclosure in present invention that non-aqueous ink is an ink that contains no water. A non-aqueous ink is not necessarily equivalent to an ink that contains no water. A non-aqueous ink can be an ink that contains carrier that is predominantly solvent but still comprises small amounts of water. Further, there is nothing in the scope of the present claims that excludes the use of small quantities of water. Additionally, there is nothing in the disclosure of Zhu et al. that indicates that the water-soluble compound, i.e. ammonium hydroxide, is only utilized when water is present in the ink. Given that the use of water is not required in Zhu et al., it is clear that the water-soluble compound of Zhu et al. is in fact utilized in ink that only contains organic solvent.

With respect to Trauernicht et al., applicants point to col.3, lines 36-37 and 53-54 of Trauernicht et al. and argue that the ink of Trauernicht et al. can be aqueous.

However, it is noted that the use of water in Trauernicht et al. is not required, i.e. solvent used "may" also be mixture of water and solvent. Further, even if in one embodiment, Trauernicht et al. does disclose ink utilizing mixture of solvent and water, the fact remains that in another embodiment, Trauernicht et al. disclose ink that contains solvent only. It is this later embodiment that meets the limitations of the present claims. Further, attention is drawn to col.5,

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lines 14-20 of Trauernicht et al. that discloses that typical ink of the invention comprises no water, i.e. 0%, solvent, and pH control agent wherein the pH control agent includes acids and bases (col.5, lines 3-13). Thus, it is clear that the disclosure of Trauernicht et al. does encompass non-aqueous inks comprising water-soluble compounds as presently claimed.

With respect to Mead et al., applicants point to col.4, lines 36-39 of Mead et al. and argue that the inks of Mead et al. can be aqueous and that water is the preferred carrier.

It is agreed that Mead et al. disclose the use of aqueous ink and that aqueous inks are preferred. However, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole discloses that in another embodiment, Mead et al. also disclose the use of non-aqueous ink. Although the preferable embodiment of Mead et al. is aqueous ink, this does not negate the fact that Mead et al. also disclose the use of non-aqueous ink as presently claimed.

With respect to Johnson et al., applicants point to col.9, line 51 that disclose aqueous inks.

However, while it is agreed that Johnson et al. disclose the use of aqueous inks, it is also significant to note that Johnson et al. disclose the use of non-aqueous ink (col.10, lines 17-49) and thus, Johnson et al. meet the limitation of the present claims. Although in one embodiment, Johnson et al. disclose the use of aqueous ink, this does not negate the equally significant

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disclosure of non-aqueous inks. Further, there is nothing in Johnson et al. that discloses that the water-soluble compound is only used in aqueous inks.

With respect to each of Zhu et al., Trauernicht et al., Mead et al., and Johnson et al., applicants argue that there is no specific teaching in the examples of non-aqueous ink including a water-soluble compound as presently claimed.

However, it is noted that “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of each of Zhu et al., Trauernicht et al., Mead et al., and Johnson et al. as described above discloses non-aqueous ink comprising water-soluble compound.

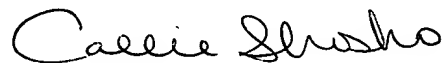
In light of the above, it is the examiner’s position that Zhu et al., Trauernicht et al., Mead et al., and Johnson et al. remain relevant references against the present claims.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/19/05